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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,391	06/10/1999	GERRIT H. SOEPENBERG	PHN-16.974	8047

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EXAMINER

LEVITAN, DMITRY

ART UNIT PAPER NUMBER

2616

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/329,391

Applicant(s)

SOEPENBERG ET AL.

Examiner

Dmitry Levitan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Amendment, filed 02/12/04, has been entered. Claims 1-14 remain pending

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

The attempt to incorporate subject matter into this application by reference to ISO/IEC International Standard 13818-6, MPEG-2 Digital Storage Media Command and Control” July 12, 1996 is ineffective because the document is not publicly available.

Drawings

3. The drawings were received on 09/04/02. These drawings are not approved, because they appear to be informal. If this is the case, when application is allowed, applicant will be required to submit new formal drawings.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not provide sufficient details to enable a skilled in the art to make and use the invention because it does not adequately describe the following:

Regarding claim 12, how to insert/extract information into/from userInfo field of a DSM-CC DownloadInfoIndication message, as the message structure, generation and destination are not properly disclosed;

The specification does not provide enough details about the structure and operation of the elements associated with the above identified claimed features to enable one skilled in the art to make and use the invention without undue experimentation.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 14 limitations directed to the version identifying information are unclear, because it is not understood what is the system element which version is identified, as all elements of the claimed system, comprising hardware and software have their versions.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claimed signal is not directed to one of the four types of statutory subject matter: a process, a machine, manufacture or composition of matter.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski (US 5,420,866) in view of Kostreski (US 5,734,589).

11. Regarding claims 1, 3, 5 and 7 Wasilewski substantially teaches the limitations of the claims:

a transmission system (see Fig. 2) for transmitting a multiplex signal 68 (see Fig. 4) from a transmitter 8 (satellite uplink) to a receiver 201(subscriber location, see col. 8 lines 1-30). Multiplex signal 68 carries Program Map Table (PMT) to each decoder (see col. 10 lines 8-30). Signal 68 has at least a module 72 (Program Definition 2 on Fig. 4) comprising at least one object 80 (Elementary Stream Definition 2 on Fig. 4).

Receiver 201 (see Fig. 6 and col. 13 lines 35-68) has extracting means (decoder 110) for extracting objects 80 from the multiplex signal 68. Decoder 110 is adapted to extract objects 80 (Elementary Stream Definition 2, Fig. 4) based on the module 72 (Program Definition 2, Fig. 4) related information 74 (Program Number, Fig. 4). Module related information 74 is included in the multiplex signal 68 (see Fig. 4).

Wasilewski does not teach using a carousel having a plurality of modules.

Kostreski teaches using a data carousel to create a customized program guide for users col. 5, line 55 through col. 6 line 6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add using a data carousel of Kostreski to the system of Wasilewski to improve the system operation for the users by creating customized program guides.

12. Regarding claims 2, 4, 6 and 8 Wasilewski discloses a transmission system (see rejection of claim 1 above) where module related information (Program Definition 2 on Fig. 4) is contained in a single information section (Program Number 74 on Fig. 4) of the transport stream 68.

13. Regarding claim 9, Wasilewski in view of Kostreski substantially teaches the limitations of the claim (see claim 1 rejection above).

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Wasilewski does not teach the objects including executable code.

Kostreski teaches downloading to the customer terminal an executable software to provide the customer with new services, col. 4 lines 39-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add executable software of Kostreski to the system of Wasilewski to improve the system operation by adding new services to produce video/audio information outputs to the customer actions.

14. Regarding claims 10, 11 and 13, Wasilewski in view of Kostreski substantially teaches the limitations of the claim (see claim 1 rejection above).

Wasilewski does not teach modules to include a pre-fetch tag for information extraction and extraction means.

Kostreski teaches tags to identify user selected broadcast channels and download/pre-fetch the available channels col. 5 line 32-54, extracting them from the broadcast stream and inherently using extraction means to extract the pre-fetch tags, because the extraction means are essential for the system operation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add pre-fetch tag for information extraction, including the extraction means, of Kostreski to the system of Wasilewski to improve the system operation by making all selected channel information available for the user.

15. Claim 14 is rejected (as best understood) under 35 U.S.C. 103(a) as being unpatentable over Wasilewski (US 5,420,866) in view of Kostreski (US 5,734,589) in further view of Cobbley (US 5,614,940).

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Wasilewski in view of Kostreski substantially teaches the limitations of the claim (see claims 1 and 13 rejection above).

Wasilewski in view of Kostreski does not teach modules to include versions and the receiver does not pre-fetch modules when the modules with the same versions are already stored in the receiver.

Cobbley teaches the modules comprise versions to identify old and new versions of the broadcasted programs and terminating the delivery of the old version when the new is available, col. 9, lines 20-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add modules to include versions and the receiver does not pre-fetch modules when the modules with the same versions are already stored in the receiver of Cobbley to the system of Wasilewski in view of Kostreski to improve the system operation by delivering the latest version of the broadcast program to the user.

Response to Arguments

16. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Levitan whose telephone number is (571) 272-3093. The examiner can normally be reached on 8:30 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on (571) 272-7529. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'DL' followed by a stylized, cursive signature.

Dmitry Levitan
Examiner
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